

Appl. No. 10/634,168
Amdt. dated April 27, 2006
Reply to Office Action of April 6, 2006

Arguments/Remarks

Examiner Christopher Bruenjes is expressly thanked for extending the courtesy of a telephone interview on 4/27/2006. During the interview, it was agreed that the deletion of the phrases "drawn and heat set" and "first elongation capabilities" in claim 8 was an apparent error and that a proposed amendment submitting these phrases would be entered, at least for the purposes of appeal. The Examiner noted that these limitations had been earlier presented and discussed. As such, they present no new issues but serve to make the claim definite. It is also noted that "drawn and heat set" and "first elongation capabilities" appear in lines 6 and 7 of current claim 8.

Examiner Bruenjes' position indicating entry of the proposed amendment is most appreciated.

Claims 8-15 stand rejected under 35 USC 112 as indefinite due to lack of proper antecedent basis.

Claim 8, as here proposed to be amended, is thought to remove this rejection.

Claims 8-12 and 14 stand rejected as anticipated by O'Neil under 35 USC 102.

The rejection of claims 8-12 and 14 states the reference O'Neil anticipates an expandable tubular fabric. The rejection states the fabric forming filaments are made of thermoplastic resins and thermoplastic rubber. It is stated the fabric is made from longitudinally extending filaments per Fig 1, ref. 11. The rejection states that while the filaments are described and shown as twisted, they are considered longitudinal. The rejection states that the longitudinal filaments are drawn since they are oriented per column 2, lines 65, 66. The rejection defines "heat set" as any filament in which the

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filament is set in some way, i.e. set twist, column 2, line 66, 68. The rejection states filament 12 is an elastic thermoplastic filament. The rejection states that since filaments 11 are thermoplastic resin and filament 12 is thermoplastic rubber, the elongation capabilities of the rubber thermoplastic filament is inherently greater. The rejection states that the elastic filament is helically wrapped and bonded to the longitudinal filaments.

As required by 37 CFR 1.111(b), specific claim limitations not taught by the reference O'Neil will be pointed to, which limitations clearly define the claims over the reference.

This rejection is traversed as the reference fails to anticipate the claimed structure as hereinafter indicated.

O'Neil, per its title, is directed to thermoplastic twine, not to a tubular fabric. Twine is defined by Webster's Collegiate Dictionary as a thread, a string, strands twisted together. Claim 8 calls for an expandable tubular fabric. Tubular is defined as a hollow cylindrical body. Clearly, O'Neil is not even directed to the same structure or article. The twine 10 of O'Neil is not a tubular fabric and is not disclosed as expandable.

The claim calls for "longitudinally extending thermoplastic filaments which are drawn and heat set to have first elongation capabilities." The specification defines heat set as yarns drawn and heated to fix desired elongation characteristics. Nowhere does O'Neil discuss yarns so treated. It is herein noted that claim terms are limited by the definitions as disclosed in the specification and the limitations put forth in the

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(57/210, 227251) of C.A.S.

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arguments.

The claim calls for elastic thermoplastic filaments having "second elongation characteristics greater than said first elongation characteristics." O'Neil does not disclose differing elongation characteristics between the filaments 11, 12. The term "oriented" as used in column 2, line 65 simply means – to bring into due relation to—. The specification simply states filaments 11 are brought into due relation to each other. Nothing implies a set twist. See also column 4, lines 38-45.

The rejection makes assumptions for the structure and elastic characteristics of the yarns 11 and 12 which are not supported by the disclosure of the patent. The patent discloses that yarns 11 and 12 may be formed of the same material or different materials, the only requirement being that the materials be compatible. See column 3, lines 47-68 and column 4, lines 1-11. Nothing states, infers, or provides for one yarn to have heat set elastic characteristics of a first dimension and the other to have elongation characteristics which are greater.

The retort that because the strands of O'Neil along the perimeter form a hollow cylindrical body and the strands inside fill the hollow is not well-founded. The outer strands cannot be so positioned without the inner strands first being in position to hold the outer strands in position. Therefore, a hollow cylindrical body is never formed.

The Examiner's position is clearly based on hindsight, i.e. it is a position which could not be reached without first reading the disclosure of the instant application and trying to conjure up an anticipating structure. Nothing supports the Examiner's position, not the disclosure of O'Neil and not *Webster's Dictionary*.

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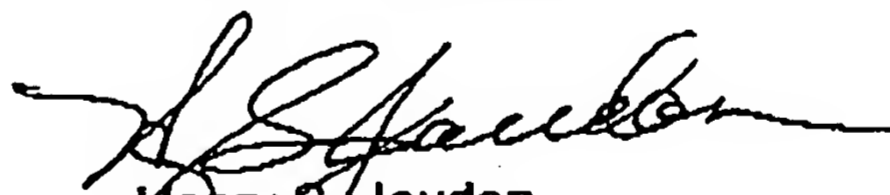
Another unfounded assertion of the rejection is that the longitudinal filaments of O'Neil are drawn since they are oriented. As used "oriented" means aligned. As defined in the specification, "drawn and heat set" requires the filament to be elongated and heat set to have a desired elongation. The reference does not disclose a yarn so treated.

Claims 9-12 and 14 all depend from claim 8 and are believed allowable for the above stated reasons.

Claims 13 and 15 are rejected under 35 USC 103 as unpatentable over O'Neil. These claims also depend from claim 8 and are believed to be allowable for the above stated reasons.

An earnest effort has been made to overcome the formal objections and rejections and place the application in condition for allowance. It is, therefore, respectfully urged that the Examiner, upon reconsideration, withdraw the rejections and pass the case to issue in the due course of PTO business.

Respectfully submitted,



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